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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,684	03/26/2001	Frank W. Sudia	10624.0004 D1	7442

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STEPTOE & JOHNSON LLP  
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EXAMINER

NALVEN, ANDREW L

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 02/11/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/816,684

Applicant(s)

SUDIA ET AL.

Examiner

Andrew L Nalven

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 4-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-20 is/are rejected.
- 7) ☒ Claim(s) 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

1. Claims 4-20 are pending.

### *Claim Objections*

2. Claim 18 is objected to because of the following informalities: Claim 18, as disclosed in the preliminary amendment, is dependent from canceled claim 1. For the remainder of the office action Examiner has interpreted the claim to be dependent from claim 12. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 4-6, 10, 12-14, and 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Vollert et al US Patent No 5,208,858. Vollert teaches a method for allocating useful data to a specific originator.
5. With regards to claims 4, 5, and 12, Vollert discloses the storing of the secret cryptographic key share securely in a first computational device at a first location (Vollert, column 4 lines 58-68) and communicating over a communication channel from the authorizing entity at a second location to the computational device at the first

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location information that identifies a document to be signed (Vollert, column 3 lines 60-65), identifies the secret cryptographic key share (Vollert, column 3 lines 65-68), and establishes authorization to use the secret cryptographic key share (Vollert, column 4 lines 42-50). Vollert further teaches the first location generating at least a partial result in a cryptographic process (Vollert, column 3 lines 65-68) and the communicating from the first location to a location other than the first location the at least partial result in the process to generate a digital signature (Vollert, column 4 lines 7-12).

6. With regards to claims 6 and 14, Vollert teaches the step of communicating an authorization to use the secret cryptographic key share including communicating a hash of the document to be signed to the first location (Vollert, column 3 lines 60-65).

7. With regards to claims 10 and 18, Vollert teaches the use of the secret cryptographic key share requires authorization from a plurality of authorizing entities, at least one of which is located remotely from the cryptographic key share (Vollert, column 2 lines 7-13 and column 4 lines 42-51).

8. With regards to claim 13, Vollert teaches the electronic service being the generation of an electronic signature (Vollert, column 3 lines 65-68).

9. With regards to claim 19, Vollert teaches the secret value being a share of a secret key of an asymmetric pair (Vollert, column 3 lines 33-40).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 7-9, 11, 15-17, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vollert et al US Patent No 5,208,858 in view of Kaliski Jr. US Patent No 6,453,416 ("Kaliski").

11. With regards to claims 7, 9, 15 and 17, Vollert fails to teach the authenticating of the authorized entity to the first computational device. Kaliski teaches the communicating of an authorization including the step of authenticating the authorizing entity to the first computational device (Kaliski, column 6 lines 6-27) by way of communicating a certificate identifying the authorizing entity. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to utilize Kaliski's authentication methods because they offers the advantage of allowing a client to authenticate itself to a server without revealing valuable information and ensuring that an impersonator or other unauthorized party does not enter into communication with a server (Kaliski, column 1 lines 17-23).

12. With regards to claims 8 and 16, Vollert as modified teaches the step of authenticating the authorizing entity including a step of signing a communication from the authorizing entity with a signature key associated with the authorizing entity (Kaliski, column 8 lines 26-41).

13. With regards to claims 11 and 20, Vollert as modified fails to teach the communication between entities being in encrypted form. Kaliski teaches the communication between entities being in encrypted form (Kaliski, column 4 lines 42-44).

***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

15. Epstein US Patent No. 6,453,416 dicloses a secure proxy signing device and method of use.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew L Nalven whose telephone number is 703 305 8407. The examiner can normally be reached on Monday - Thursday 8-6, Alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on 703 308 4789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Andrew Nalven

ALN

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*Matthew D. Smithers*  
MATTHEW SMITHERS  
PRIMARY EXAMINER  
*Art Unit 2137*